

REMARKS/ARGUMENTS

Claims 1, 4-12 and 19-27 are pending. By this amendment, claims 14-18 and 28 are cancelled without prejudice or disclaimer. Reconsideration in view of the above amendments and following remarks is respectfully requested.

Applicants appreciate the courtesies extended by Examiner Patel to applicant's representative during the personal interview conducted November 5, 2007. The points discussed during the interview are summarized in the remarks below.

It is respectfully submitted that the finality of the September 20, 2007 Office Action is premature. M.P.E.P. §707.07(f) states:

where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

M.P.E.P. §706.07 states:

The Examiner should never lose sight of the fact that in every case that applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicant's as a class as well as to that of the public that prosecution of an application should be confined to as few actions as is consistent with a thorough consideration of its merits.

In the Office Action dated April 10, 2007, the Examiner relied on the rationale of the court as used in In re Aller, 105 USPQ 233, in the rejection of claims 8-12 and 20-24. In the response filed July 9, 2007, applicants specifically traversed the Examiner's reliance on the courts rationale, for example, on pages 13-15, of the response.

The September 20, 2007 Office Action does not address the substance of applicant's arguments regarding the Examiner's reliance on the courts rationale in In re Aller. Therefore, the finality of the September 20, 2007 Office Action is premature and must be withdrawn. As

the finality of the September 20, 2007 Office Action must be withdrawn, the instant amendment should be entered. See M.P.E.P. §706.07(c).

Claims 7, 13, 19 and 25-27 were rejected under 35 U.S.C. §102(e) over Palkon et al. (U.S. Patent 7,007,696) and claims 8-12 and 20-24 were rejected under 35 U.S.C. §103(a) over Palkon et al. The rejections are respectfully traversed.

Claim 7 recites a nasal mask having a relatively rigid mask frame and a relatively softer cushion provided to the frame. The cushion comprises an outer membrane including a face-contact portion to form a seal with the patient; a frame connection portion opposite the face-contact portion; an inwardly sloping or stepped outer wall between the outer membrane and the frame connection portion; and an underlying rim positioned below the membrane. The membrane and the rim are formed and positioned with respect to one another to accommodate at least one of a pre-adult patient or a small sized adult patient. The cushion includes a nasal bridge region, a top lip region, and two side regions. A projected area of the framed connection portion is generally larger than an area defined by the face-contact portion of the membrane.

As discussed during the interview, Figures 3, 4 and 5 of Palkon et al. are shown in cross-section in Figures 6, 7 and 9 of Palkon et al. As also discussed during the interview, the sidewall 45, 45a, 45b of the cushion of Palkon et al. is not inwardly sloped or stepped. As clearly shown in Figures 6 and 7, the sidewall extends perpendicular to the frame engaging portion 32 of the cushion. The sidewall shown in the second embodiment of Palkon et al. of Figures 8 and 9 also extends perpendicular to the frame engaging portion 132 and is not inwardly sloped or stepped, as recited in claim 7. Furthermore, as also discussed during the interview, the sidewall 150 shown in the third embodiment of Figures 10A and 10B of Palkon et al. has a sinous portion and an arcuate portion 153, but is not inwardly sloped or stepped, as recited in claim 7.

During the interview, Examiner Patel noted that column 4, lines 36-47, of Palkon et al. describes Figure 6 and discloses that the thickness of the sidewall 45a just above the channel 41 may be just slightly thicker than the thickness of the inner membrane 46a. Examiner Patel stated that as the sidewall 45a may have a variable thickness, such a disclosure may be interpreted as the sidewall being inwardly sloped or stepped. Examiner Patel also stated that the membrane 46 and/or the membrane 47 may be regarded as part of the sidewall of Palkon et al. and that the membranes 46 and/or 47 may be regarded as inwardly sloped. Applicants respectfully disagree.

As discussed during the interview, Palkon et al. disclose that the thickness of the sidewall diminishes from the inner membrane 46 to the outer membrane 48. Finally, the sidewall 45 becomes the outer membrane 48. See column 4, lines 39-42. It is respectfully submitted that it is clear from this disclosure of Palkon et al. that the inner membrane 46 and/or the middle membrane 47 are not part of the sidewall 45 of the cushion, and such an interpretation is not fair reading of the disclosure of the Palkon et al. reference. Moreover, it is respectfully noted that claim 7 recites that the cushion comprises an outer membrane including a face-contact portion to form a seal with a patient, a frame connection portion opposite the face contact portion, an inwardly sloping or stepped outer wall between the outer membrane and the frame connection portion, and an underlying rim positioned below the membrane. Accordingly, in order to anticipate claim 7, Palkon et al. must disclose each and every feature recited in claim 7 in as much detail as is recited in the claim. Therefore, at best, the inner membrane 46 and the middle membrane 47 cannot be interpreted as part of the sidewall as such an interpretation would result in Palkon et al. failing to disclose or suggest the underlying rim recited in claim 7.

Furthermore, as discussed during the interview, a fair reading of Palkon et al. would not include considering the membranes 46 and/or 47 as part of the sidewall. Palkon et al. clearly

disclose that the sidewall extends from the frame engaging portion 32 to the outer membrane 48. For example, column 4, lines 39-40, of Palkon et al. discloses that the thickness of the sidewall 45 diminishes from the inner membrane 46 to the outer membrane 48. A fair reading of this disclosure would not result in the membranes 46 and/or 47 being considered part of the sidewall 45.

Claims 8-12 and 19-27 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claim 7 and for the additional features recited therein. Moreover, as discussed during the interview, the features recited in claims 8-12 and 18-24 would not have been obvious to one of ordinary skill in the art in view of the rationale used by the court in In re Aller, 105 USPQ 233, as Palkon et al. do not disclose or suggest the general conditions of the claims, nor does Palkon et al. disclose overlapping ranges to those recited in the claims. Applicants also respectfully resubmit that the rejections of claims 8-12 and 18-24 relying upon In re Aller are improper and insufficient for the reasons discussed in the July 9, 2007 response.

Claims 8-12 and 18-24 recite additional dimensions of various claimed features of the application, none of which are recognized as result-effective variables by Palkon et al. Accordingly, each of claims 10, 11 and 18-24 are non-obvious over Palkon et al.

Reconsideration and withdrawal of the rejections over Palkon et al. are respectfully requested.

In view of the above amendments and remarks, applicants respectfully submit that all of the claims are allowable and that the entire application is in condition for allowance.

Should the Examiner believe that anything further is necessary to place the application in condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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